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EXAMINER

POKRZYWA, J

ART UNIT	PAPER NUMBER
2622	8

DATE MAILED: 8/1/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/146,069

Applicant(s)

YOSHIDA, TAKEHIRO

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 6 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment was received on 5/8/01, and has been entered and made of record. Currently, claims 1 through 25 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to **claims 12, 18, 19, and 22**, filed 5/8/01, have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant's arguments with respect to **claims 1, 2, 5, 9, 10, 11, and 20**, filed 5/8/01, have been fully considered but they are not persuasive.

4. In response to applicant's arguments regarding the rejection of **claim 1**, as being anticipated by Gordon (U.S. Patent Number 5,608,786), which states on page 10 that Gordon fails to teach of a means that transmits facsimile data to a recipient over the Internet and a notification means that signals the recipient that the facsimile is being sent. The examiner notes the current limitations in claim 1, which state "facsimile communication means for performing facsimile communication through the Internet by dial-up connection with a station, and notification means for notifying the station using a PSTN that the facsimile communication through the Internet has been executed." The claim does not specifically require "signaling the recipient that the facsimile is being sent", as argued, but rather "notifying the station using a PSTN that the facsimile communication through the Internet has been executed." Gordon teaches of a means for notifying a station which received a facsimile communication (computer 12,

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telephone 29, and facsimile 31 in Fig. 3, or facsimile 62 in Fig. 4) using a PSTN that the facsimile communication through the Internet has been executed (column 7, lines 18 through 66, and column 10, lines 21 through 65, wherein even though a recipient is required to access the provider, the recipient is still “notified using a PSTN that the facsimile communication has been executed”, as required by the claim). Therefore, the rejection of *claims 1 and 9*, as cited in the Office action dated 11/8/00, as being anticipated by Gordon, is maintained and repeated in this Office action.

5. In response to applicant’s arguments regarding the rejection of *claim 1*, as being anticipated by Ho (U.S. Patent Number 5,805,298), which states on page 11 that Ho fails to teach of a system that transmits facsimile data and notifies the recipient of the transmission. As discussed above, the claim does not specifically require “signaling the recipient that the facsimile is being sent”, as argued, but rather “notifying the station using a PSTN that the facsimile communication through the Internet has been executed.” Ho teaches of a means for notifying a station which received a facsimile communication (destination communication device 100, used for retrieval of e-mail messages) using a PSTN (PSTN 106, wherein as seen in Fig. 1, the PSTN connects the communication device 100 with the router 107) that the facsimile communication through the Internet has been executed (step 416 of Fig. 4, column 8, lines 18 through 37, wherein a facsimile communication, having been transmitted through the Internet, as seen in Fig. 3, is stored in electronic mailbox 104 or 105, which is then accessed by a communications device 100, wherein even though a recipient is required to access the device, the recipient is still “notified using a PSTN that the facsimile communication has been executed”, as required by the

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claim). Therefore, the rejection of **claims 1 and 9**, as cited in the Office action dated 11/8/00, as being anticipated by Ho *et al.*, is maintained and repeated in this Office action.

6. In response to applicant's arguments regarding the rejection of amended **claim 20**, as being anticipated by Foladare *et al.* (U.S. Patent Number 5,905,777), which states on page 12 that Foladare fails to teach of a communication apparatus comprising a transmission means that transmits data to a recipient and a notification means that uses another form of transmission to signal the recipient that the transmission means is prepared to transmit the data. After review of Foladare, the examiner finds that the amended claim does not overcome the rejection. Foladare teaches of a means for transmitting data (through line 63 and telephone network 64 to facsimile 72 or 72', or personal computer 70 or 70'), and means (paging system 66, or cable TV system 66') for notifying, by a method different from that of the transmission means, that the transmission means is prepared to transmit the data (column 5, line 48 through column 6, line 32, and column 7, lines 31 through 51, wherein a notification is made to pager 74 asking the recipient which device to forward a message, as the server 60 is prepared to transmit the data, and depending on which buttons the recipient presses, the message is then transmitted to one of facsimiles 72 and 72', or personal computers 70 and 70', as read in column 5, lines 51 through 53). Therefore, the rejection of **claim 20**, as cited in the Office action dated 11/8/00, as being anticipated by Foladare *et al.*, is maintained and repeated in this Office action.

7. In response to applicant's arguments regarding the rejection of **claims 1, 2, 5, and 9-11**, as being unpatentable over Cooper *et al.* (U.S. Patent Number 6,052,442) in view of Kulakowski

(WIPO Publication Number WO 97/10668), which states on pages 14 and 15 that since Cooper fails to teach of notifying the station using a PSTN that the facsimile communication through the Internet has been executed and Kulakowski teaches of sending the electronic mail message after receipt of the message, the combination of Cooper and Kulakowski cannot be relied upon. As discussed in the Office action dated 11/8/00, Cooper teaches the limitations in the claims except for using specifically a PSTN, as Cooper notifies the station using a telephone line 5, as read in column 4, lines 30 through 47. Kulakowski teaches of a system, having similarities in structure to the system of Cooper, which utilizes a PSTN for notification for a received message. Because of this, it would be obvious to a person of ordinary skill in the art at the time the invention was made to incorporate Kulakowski's teachings in the system of Cooper, thereby conforming with industry standards, as using a PSTN is widely known and used throughout the art to connect facsimile devices together or to an Internet service provider, as recognized by Kulakowski. Therefore, the rejection of *claims 1, 2, 5, and 9-11*, as cited in the Office action dated 11/8/00, as being unpatentable over Cooper *et al.* in view of Kulakowski, is maintained and repeated in this Office action. It is further noted that upon review of Cooper, the examiner finds that the combination of Cooper and Kulakowski still teaches the claims, as amended (see discussion below).

### ***Claim Rejections - 35 USC § 112***

8. The rejection of **claims 16 through 19**, as cited in the Office action dated 11/8/00, is overcome by the changes set forth in the amendment.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. **Claims 1 and 9** are rejected under 35 U.S.C. 102(e) as being anticipated by Gordon (U.S. Patent Number 5,608,786, cited in the Office action dated 11/8/00).

Regarding **claims 1 and 9**, Gordon discloses a communication apparatus (UniPost access node) and method comprising a means for performing facsimile communication through the Internet (column 8, lines 1 through 44) by dial-up connection (column 6, lines 21 through 33) with a station (computer 12, telephone 29, and facsimile 31 in Fig. 3, or facsimile 62 in Fig. 4), and means for notifying the station (computer 12, telephone 29, and facsimile 31 in Fig. 3, or facsimile 62 in Fig. 4) using a PSTN that the facsimile communication through the Internet has been executed (column 7, lines 18 through 66, and column 10, lines 21 through 65).

11. **Claims 1 and 9** are rejected under 35 U.S.C. 102(e) as being anticipated by Ho *et al.* (U.S. Patent Number 5,805,298, cited in the Office action dated 11/8/00).

Regarding **claim 1**, Ho discloses a communication apparatus (communications device 100) comprising a means for performing facsimile communication through the Internet (see Figs. 1 and 3) by dial-up connection (column 3, line 53 through column 4, line 6) with a station (destination communication device 100, whereby the communications device retrieves e-mail

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messages stored in electronic mailboxes 104 or 105), and means for notifying the station (destination communication device 100, used for retrieval of e-mail messages) using a PSTN (PSTN 106, wherein as seen in Fig. 1, the PSTN connects the communication device 100 with the router 107) that the facsimile communication through the Internet has been executed (step 416 of Fig. 4, column 8, lines 18 through 37, wherein a facsimile communication, having been transmitted through the Internet, as seen in Fig. 3, is stored in electronic mailbox 104 or 105, which is then accessed by a communications device 100).

Regarding *claim 9*, Ho discloses a communication method (see Figs. 3 and 4) comprising a step of performing facsimile communication through the Internet (see Figs. 1 and 3) by dial-up connection (column 3, line 53 through column 4, line 6) with a station (destination communication device 100, whereby the communications device retrieves e-mail messages stored in electronic mailboxes 104 or 105), and a step of notifying the station (destination communication device 100, used for retrieval of e-mail messages) using a PSTN (PSTN 106, wherein as seen in Fig. 1, the PSTN connects the communication device 100 with the router 107) that the facsimile communication through the Internet has been executed (step 416 of Fig. 4, column 8, lines 18 through 37, wherein a facsimile communication, having been transmitted through the Internet, as seen in Fig. 3, is stored in electronic mailbox 104 or 105, which is then accessed by a communications device 100).



12. **Claims 20, 22, and 25** are rejected under 35 U.S.C. 102(e) as being anticipated by Foladare *et al.* (U.S. Patent number 5,905,777, cited in the Office action dated 11/8/00).

Regarding *claim 20*, Foladare discloses a communication apparatus (e-mail server 60) comprising means for transmitting data (through line 63 and telephone network 64 to facsimile 72 or 72', or personal computer 70 or 70'), and means (paging system 66, or cable TV system 66') for notifying, by a method different from that of the transmission means, that the transmission means is prepared to transmit the data (column 5, line 48 through column 6, line 32, and column 7, lines 31 through 51, wherein a notification is made to pager 74 asking the recipient which device to forward a message, as the server 60 is prepared to transmit the data, and depending on which buttons the recipient presses, the message is then transmitted to one of facsimiles 72 and 72', or personal computers 70 and 70', as read in column 5, lines 51 through 53).

Regarding *claim 22*, Foladare discloses a communication apparatus (e-mail server 60, seen in Figs. 1 and 2) comprising first means (telephone network I/O adapter 210) for sending data over a first communication network (telephone network 64), second means (paging system I/O adapter 206) for sending data over a second communication network (radio link 75), and third means (processor 212) for controlling the first means and the second means (being inherent in the operation of the system), wherein the third means controls the second means so as to send data (pager notification) corresponding to sending operation of the first means (column 5, line 48 through 67), and wherein the sending operation of the second means indicates that the first means is prepared to send data over the first communication network (column 5, line 48 through column 6, line 32, wherein a notification is made to pager 74 asking the recipient which device

to forward a message, as the server 60 is prepared to transmit the data, and depending on which buttons the recipient presses, the message is then transmitted to one of facsimiles 72 and 72', or personal computers 70 and 70', as read in column 5, lines 51 through 53).

Regarding *claim 25*, Foladare discloses the apparatus discussed above in claim 22, and further teaches that the data sent by the second means is a part of data sent by the first means (column 5, line 48 through 67).

13. **Claims 20 through 24** are rejected under 35 U.S.C. 102(e) as being anticipated by Williams *et al.* (U.S. Patent number 6,192,045).

Regarding *claim 20*, Williams discloses a communication apparatus (originating fax callback device FCD, see Figs. 8 through 12) comprising means for transmitting data (step 79 in Fig. 12, through Internet 60), and means for notifying (through long distance carrier 59), by a method different from that of the transmission means (column 8, line 44 through column 9, line 29), that the transmission means is prepared to transmit the data (steps 73 through 76 in Fig. 12).

Regarding *claim 21*, Williams discloses the apparatus discussed above in claim 20, and further teaches that the transmission means transmits the data through the Internet (60, see Figs. 9 through 11), and the notification means transmits notification through a public telephone network (long distance carrier 59, see Figs. 9 through 11).

Regarding *claim 22*, Williams discloses a communication apparatus (originating fax callback device FCD, see Figs. 8 through 12) comprising first means for sending data over a first communication network (step 79 in Fig. 12, through Internet 60), second means for sending data over a second communication network (steps 73 through 76 in Fig. 12, through long distance

carrier 59), and third means (CPU 111) for controlling the first means and the second means (column 9, lines 46 through 61, being inherent to the operation of a CPU), wherein the third means controls the second means so as to send data corresponding to sending operation of the first means, and wherein the sending operation of the second means indicates that the first means is prepared to send data over the first communication network (column 8, line 44 through column 9, line 29).

Regarding *claim 23*, Williams discloses the apparatus discussed above in claim 22, and further teaches that the first communication network is a facsimile communication network (see Fig. 11, column 9, lines 21 through 37)

Regarding *claim 24*, Williams discloses the apparatus discussed above in claim 22, and further teaches that the second communication network is a telephone network (long distance carrier 59, see Figs. 9 through 11).

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 1, 2, and 4 through 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper *et al.* (U.S. Patent Number 6,052,442, cited in the Office action dated 11/8/00) in view of Kulakowski (WIPO Publication Number WO 97/10668, cited in the Office action dated 11/8/00).

Regarding *claim 1 and 9*, Cooper discloses a communication apparatus (Internet answering machine seen in Fig. 1) and method comprising a means for performing facsimile communication (column 6, lines 38 through 40) through the Internet (column 1, lines 41 through 56) by dial-up connection (step 74 in Fig. 3, and step 94 in Fig. 5, column 10, lines 40 through 43) with a station (display 16), and means for notifying the station using a telephone line (5, column 4, lines 30 through 47) that the facsimile communication through the Internet has been executed (step 54 in Fig. 2-1, or step 80 in Fig. 3, column 8, line 21 through column 9, line 13, and seen in Fig. 4).

However, Cooper fails to specifically teach of notifying the station **using a PSTN** that the facsimile communication through the Internet has been executed. Kulakowski discloses a communication apparatus (see Figs. 1 through 3, interface apparatus 26) comprising a means for performing facsimile communication through the Internet by dial-up connection (see abstract, and page 13, lines 11 through 36) with a station (display 43), and means for notifying the station using a PSTN (telephone connections 16 and 30, being a PSTN, page 8, lines 3 through 23) that the facsimile communication through the Internet has been executed (process of Fig. 5, steps 76 through 98, and page 18, lines 16 through 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's teachings in Cooper's system. Cooper's system would conform with industry standards, and would easily be modified to incorporate Kulakowski's teachings, as using a PSTN is widely known and used throughout the art to connect facsimile devices together or to an Internet service provider, as recognized by Kulakowski.

Regarding *claim 2 and 10*, Cooper discloses a communication apparatus (Internet answering machine seen in Fig. 1) and a control method for the communication apparatus comprising a means for performing facsimile communication (column 6, lines 38 through 40) through the Internet (column 1, lines 41 through 56) by dial-up connection (step 74 in Fig. 3, and step 94 in Fig. 5, column 10, lines 40 through 43), and means for, when it is notified by a calling party communication apparatus (service provider central computer, column 1, lines 41 through 48, which is calling the communication apparatus, column 2, lines 57 through column 3, line 4, and steps 46 and 54 in Fig. 2-1) using a telephone line (5, column 4, lines 30 through 47) that communication through the Internet has been executed by dial-up connection (step 54 in Fig. 2-1, or step 80 in Fig. 3, column 8, lines 21 through 38), setting up connection to the Internet by dial-up connection (step 94 in Fig. 5, column 10, lines 25 through 55) and receiving facsimile communication information through the Internet by POP (column 1, lines 41 through 67, and column 10, lines 43 through 64).

However, Cooper fails to specifically teach of notifying the station **using a PSTN** that communication through the Internet has been executed. Kulakowski discloses a communication apparatus (see Figs. 1 through 3, interface apparatus 26) comprising a means for performing facsimile communication through the Internet by dial-up connection (see abstract, and page 13, lines 11 through 36) with a station (display 43), and means for notifying the station using a PSTN (telephone connections 16 and 30, being a PSTN, page 8, lines 3 through 23) that the facsimile communication through the Internet has been executed (process of Fig. 5, steps 76 through 98, and page 18, lines 16 through 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's teachings

in Cooper's system. Cooper's system would conform with industry standards, and would easily be modified to incorporate Kulakowski's teachings, as using a PSTN is widely known and used throughout the art to connect facsimile devices together or to an Internet service provider, as recognized by Kulakowski.

Regarding *claim 4*, Cooper and Kulakowski disclose the apparatus discussed above in claim 2, and Cooper further teaches of a means for registering a time of execution of POP processing on the basis of a user operation (step 70 in Fig. 3, column 8, lines 14 through 20), and wherein the reception means set up connection to the Internet at the registered time and receive the facsimile communication information through the Internet by POP ("yes" branch of step 72, leading to steps 74, 76, and 80, column 8, lines 20 through 38).

Regarding *claim 5*, Cooper discloses a communication apparatus (Internet answering machine seen in Fig. 1) capable of facsimile communication (column 6, lines 38 through 40) through the Internet (column 1, lines 41 through 56) by dial-up connection (step 74 in Fig. 3, and step 94 in Fig. 5, column 10, lines 40 through 43), comprising a means (display 16) for, when it is notified by a calling party communication apparatus (service provider central computer, column 1, lines 41 through 48, which is calling the communication apparatus, column 2, lines 57 through column 3, line 4, and steps 46 and 54 in Fig. 2-1) using a telephone line (5, column 4, lines 30 through 47) that communication through the Internet has been executed (step 54 in Fig. 2-1, or step 80 in Fig. 3, column 8, lines 21 through 38), displaying information representing that communication through the Internet has been executed (see Fig. 4, column 8, line 54 through column 9, line 13) and station address information (column 9, lines 7 through 13) of a calling party (see step 90 in Fig. 3, column 8, lines 44 through 49), and a means for determining on the

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basis of selection by a user whether the apparatus is to set up connection to the Internet by dial-up connection (step 94 in Fig. 5, column 10, lines 25 through 55) to receive facsimile communication information through the Internet by POP (column 1, lines 41 through 67, and column 10, lines 43 through 64).

However, Cooper fails to specifically teach of notifying **using a PSTN** that communication through the Internet has been executed. Kulakowski discloses a communication apparatus (see Figs. 1 through 3, interface apparatus 26) capable of facsimile communication through the Internet by dial-up connection (see abstract, and page 13, lines 11 through 36), comprising a means (display 43) for, when it is notified using a PSTN (telephone connections 16 and 30, being a PSTN, page 8, lines 3 through 23) that communication through the Internet has been executed (process of Fig. 5, steps 76 through 98), displaying information representing that communication through the Internet has been executed and station address information of a calling party (page 18, lines 16 through 26), and a means for determining on the basis of selection by a user (page 18, lines 25 and 26) whether the apparatus is to receive facsimile communication information through the Internet by POP (page 2, lines 8 through 24). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's teachings in Cooper's system. Cooper's system would conform with industry standards, and would easily be modified to incorporate Kulakowski's teachings, as using a PSTN is widely known and used throughout the art to connect facsimile devices together or to an Internet service provider, as recognized by Kulakowski.

Regarding *claim 6*, Cooper and Kulakowski disclose the apparatus discussed above in claim 5, and Cooper further teaches of a means for registering whether, when it is notified using

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the PSTN (being obvious in view of Kulakowski, discussed above) that communication through the Internet has been executed (step 90 of Fig. 3), dial-up connection is to be immediately performed on the basis of a station address of the calling party (column 9, lines 40 through 49, and column 5, lines 54 through 66, step 46 in Fig. 2-1) to receive the facsimile communication information through the Internet by POP (column 1, lines 41 through 67, and column 10, lines 43 through 64).

Regarding *claim 7*, Cooper and Kulakowski disclose the apparatus discussed above in claim 5, and Cooper further teaches that when dial-up connection is performed to receive the facsimile communication information through the Internet (step 94 of Fig. 5), all pieces of facsimile communication information received by a service provider are received (column 10, lines 40 through 64).

Regarding *claim 8*, Cooper and Kulakowski disclose the apparatus discussed above in claim 5, and Cooper further teaches of display means (display 16) for, when it is notified using the PSTN (being obvious in view of Kulakowski, discussed above) that communication through the Internet has been executed (step 90 of Fig. 3), displaying a list of communication management information independently of communication management information associated with normal transmission/reception (see Fig. 4, column 9, lines 7 through column 10, line 15), and means (display 16) for displaying, in correspondence with the notification, whether reception of the facsimile communication information from the service provider is complete (column 10, line 65 through column 11, line 14).

Regarding *claim 11*, Cooper discloses a control method for a communication apparatus (Internet answering machine seen in Fig. 1) capable of facsimile communication (column 6, lines



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38 through 40) through the Internet (column 1, lines 41 through 56) by dial-up connection (step 74 in Fig. 3, and step 94 in Fig. 5, column 10, lines 40 through 43), comprising, when it is notified by a calling party communication apparatus (service provider central computer, column 1, lines 41 through 48, which is calling the communication apparatus, column 2, lines 57 through column 3, line 4, and steps 46 and 54 in Fig. 2-1) using a telephone line (5, column 4, lines 30 through 47) that communication through the Internet has been executed (step 54 in Fig. 2-1, or step 80 in Fig. 3, column 8, lines 21 through 38), displaying (using display 16) information representing that communication through the Internet has been executed (see Fig. 4, column 8, line 54 through column 9, line 13) and station address information (column 9, lines 7 through 13) of the calling party communication apparatus (see step 90 in Fig. 3, column 8, lines 44 through 49, and Fig. 4, wherein a received e-mail is from "ROBIN@CR.COM", whereby "CR.COM" provides station address information of the service provider, being the calling party communication apparatus), and determining on the basis of selection by a user whether the apparatus is to set up connection to the Internet by dial-up connection (step 94 in Fig. 5, column 10, lines 25 through 55) to receive facsimile communication information through the Internet by POP (column 1, lines 41 through 67, and column 10, lines 43 through 64).

However, Cooper fails to specifically teach of notifying **using a PSTN** that communication through the Internet has been executed. Kulakowski discloses a control method for a communication apparatus (see Figs. 1 through 3, interface apparatus 26) capable of facsimile communication through the Internet by dial-up connection (see abstract, and page 13, lines 11 through 36), comprising a display step (using display 43) of, when it is notified using a PSTN (telephone connections 16 and 30, being a PSTN, page 8, lines 3 through 23) that

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communication through the Internet has been executed (process of Fig. 5, steps 76 through 98), displaying information representing that communication through the Internet has been executed and station address information of a calling party (page 18, lines 16 through 26), and a step of determining on the basis of selection by a user (page 18, lines 25 and 26) whether the apparatus is to receive facsimile communication information through the Internet by POP (page 2, lines 8 through 24). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's teachings in Cooper's system. Cooper's system would conform with industry standards, and would easily be modified to incorporate Kulakowski's teachings, as using a PSTN is widely known and used throughout the art to connect facsimile devices together or to an Internet service provider, as recognized by Kulakowski.

16. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper *et al.* (U.S. Patent Number 6,052,442, cited in the Office action dated 11/8/00) in view of Kulakowski (WIPO Publication Number WO 97/10668, cited in the Office action dated 11/8/00), and further in view of Obhan (U.S. Patent Number 5,875,302, cited in the Office action dated 11/8/00).

Regarding *claim 3*, Cooper and Kulakowski disclose the system discussed above in claim 1, but fail to specifically teach of a means for selecting on the basis for a user operation whether the communication is an important communication, and wherein when the important communication is not selected, notification means do not notify the station using a PSTN that the facsimile communication through the Internet has been executed. Obhan discloses a communication apparatus (server 150) comprising a means for performing a communication

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through the Internet (e-mail communication) with a station (users 112, column 4, line 65 through column 5, line 13), and a means for notifying the station (notification interface 106) that the communication through the Internet has been executed (column 17, lines 5 through 37). Further, Obhan teaches of a means for selecting on the basis for a user operation whether the communication is an important communication (notification priority 206, column 6, lines 28 through 36), and wherein when the important communication is not selected, notification means do not notify the station that the communication through the Internet has been executed (column 6, line 66 through column 7, line 9). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Obhan's teachings in Cooper and Kulakowski's system, therein including a means for selecting on the basis for a user operation whether the communication is an important communication, and wherein when the important communication is not selected, notification means do not notify the station using a PSTN that the facsimile communication through the Internet has been executed. The system of Cooper and Kulakowski would become more efficient with the addition of Obhan's teachings, as notifications would only be sent when high priority is designated, therein not tying up the system with unnecessary communications over the telephone network.

17. **Claims 12, 13, 18, and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mordowitz *et al.* (U.S. Patent Number 6,011,794) in view of Bloomfield (U.S. Patent Number 6,025,931).

Regarding *claims 12 and 18*, Mordowitz discloses a communication apparatus (first ITA 10), with a control method, capable of facsimile communication through the Internet (90, see

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Fig. 1, and abstract) by dial-up connection (column 4, lines 10 through 20), comprising means for performing dial-up connection from a station A (calling telephone 16) to an Internet service provider (ISP 11) to execute communication with a station B (second ITA 20, see Figs. 1 and 4, steps 82 through 92) *having an e-mail address* through the Internet (see Fig. 1), and means for calling the station B from the station A, when the dial-up connection is established using a general public network (POTS, see Figs. 1 and 4) to transmit information representing that facsimile communication has been executed through the Internet and description information of the facsimile communication executed through the Internet (step 98 in Fig. 4, column 4, lines 21 through 36).

However, Mordowitz does not specifically teach if station B has a TCP/IP address, as the station has an e-mail address. Bloomfield discloses a communication apparatus (fax interface device 102) capable of facsimile communication through the Internet (email network 116), comprising means for performing dial-up connection from a station A (fax device 106) to an Internet service provider (e-mail server 112) to execute communication with a station B (e-mail device 118) *having a TCP/IP address* through the Internet (column 7, lines 35 through 53). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Mordowitz's system. Mordowitz's system would easily be implemented with Bloomfield's teachings, as an e-mail address is well known within the art to be a TCP/IP address, as recognized by Bloomfield, thereby conforming to industry standards.

Regarding *claim 13*, Mordowitz and Bloomfield disclose the apparatus discussed above in claim 12, and Mordowitz further teaches that the description information is summarized text

representing a summary of facsimile communication column 6, lines 11 through 24, wherein the intended telephone number is summarized text).

Regarding *claim 19*, Mordowitz discloses a computer readable storage medium (ROM 28, column 3, lines 26 through 31) which stores a program (program 60, seen in Fig. 3, column 3, line 65 through column 4, line 9) for controlling a communication apparatus (first ITA 10), with a control method, capable of facsimile communication through the Internet (90, see Fig. 1, and abstract) by dial-up connection (column 4, lines 10 through 20), comprising code for establishing a dial-up connection from a station A (calling telephone 16) to an Internet service provider (ISP 11) to execute communication with a station B (second ITA 20, see Figs. 1 and 4, steps 82 through 92) *having an e-mail address* through the Internet (see Fig. 1), and code for calling the station B from the station A, when the dial-up connection is established using a general public network (POTS, see Figs. 1 and 4) to transmit information representing that facsimile communication has been executed through the Internet and description information of the facsimile communication executed through the Internet (step 98 in Fig. 4, column 4, lines 21 through 36).

However, Mordowitz does not specifically teach if station B has a TCP/IP address, as the station has an e-mail address. Bloomfield discloses a communication apparatus (fax interface device 102) capable of facsimile communication through the Internet (email network 116), comprising means for performing dial-up connection from a station A (fax device 106) to an Internet service provider (e-mail server 112) to execute communication with a station B (e-mail device 118) *having a TCP/IP address* through the Internet (column 7, lines 35 through 53). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the

invention was made to include Bloomfield's teachings in Mordowitz's system. Mordowitz's system would easily be implemented with Bloomfield's teachings, as an e-mail address is well known within the art to be a TCP/IP address, as recognized by Bloomfield, thereby conforming to industry standards.

18. **Claims 14 through 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mordowitz *et al.* (U.S. Patent Number 6,011,794) in view of Bloomfield (U.S. Patent Number 6,025,931), and further in view of Bobo, II (U.S. Patent Number 5,675,507, cited in the Office action dated 11/8/00).

Regarding *claim 14*, Mordowitz and Bloomfield disclose the apparatus discussed above in claim 12, but fail to specifically teach if the description information is information of a first page of facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37). Further, Bobo teaches that the description information is information of a first page of facsimile information transmitted through the Internet (column 9, lines 2 through 17). Therefore, it would have been obvious to a person of

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ordinary skill in the art at the time the invention was made to include Bobo's teachings in Mordowitz's system. Mordowitz's system would become more user friendly if adapted to incorporate Bobo's teachings, as the user would be able to quickly scroll through cover pages of transmitted messages, without downloading the entire message.

Regarding *claim 15*, Mordowitz and Bloomfield disclose the apparatus discussed above in claim 12, but fail to specifically teach of transmitting a number of pages of facsimile information transmitted through the Internet and a communication time. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37). Further, Bobo teaches that the notification means further transmits the number of pages of facsimile information transmitted through the Internet (column 8, lines 53 through 60) and a communication time (column 8, lines 53 through 60). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in Mordowitz's system. Mordowitz's system would become more user friendly if adapted to incorporate Bobo's teachings, as the user would be able to determine display options based on

the number of pages of transmitted facsimile messages, and the communication time, without downloading the entire message.

Regarding *claim 16*, Mordowitz and Bloomfield disclose the apparatus discussed above in claim 12, but fail to specifically teach of a means for selecting, as the description information to be transmitted, either summarized text representing a summary of facsimile communication or information of a first page of facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37). Further, Bobo teaches of a means for selecting, as the description information to be transmitted, either summarized text representing a summary of facsimile communication (column 8, lines 53 through 63) or information of a first page of facsimile information transmitted through the Internet (column 9, lines 2 through 30). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in Mordowitz's system. Mordowitz's system would become more user friendly if adapted to incorporate Bobo's teachings, as the user would be able to determine display options, without downloading the entire message.



19. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Mordowitz *et al.* (U.S. Patent Number 6,011,794) in view of Bloomfield (U.S. Patent Number 6,025,931), and further in view of Wegner *et al.* (U.S. Patent Number 5,712,907, cited in the Office action dated 11/8/00).

Regarding **claim 17**, Mordowitz and Bloomfield disclose the apparatus discussed above in claim 12, and Mordowitz further teaches of a means for transmitting the facsimile information from the station A to the station B through the general public network without performing communication by the Internet communication execution means (see Fig. 4, “no” branch of step 84, leading to steps 86 and 88, column 4, lines 21 through 35). However, Mordowitz and Bloomfield fail to teach of transmitting the facsimile information through the general public network when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value. Wegner discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (column 4, lines 7 through 11), comprising means for performing dial-up connection from a station A (message communicating device 2s) to an Internet service provider (network node 6s) to execute communication with a station B (message communicating devices 1r, 2r, or 3r) having a TCP/IP address through the Internet (column 8, lines 31 and 32, and column 13, line 64 through column 14, line 3), and means for, when communication by the Internet communication execution means has been executed, calling the station B (recipient 8r in Fig. 7a) using a general public network (PSTN 5) to transmit information representing that facsimile communication has been executed through the Internet and description information of the facsimile communication executed through the Internet (column 3, lines 52 and 53). Further,

Wegner teaches of a means (least cost routing processor 103) for, when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value (column 10, lines 21 through 23, and column 12, lines 59 through 62, wherein the number of pages of the message corresponds to the size of the message), transmitting the facsimile information from the station A to the station B through the general public network (PSTN 5) without performing communication by the Internet communication execution means (column 3, lines 54 65, and column 7, lines 25 through 62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Wegner's teachings in Mordowitz's system, thereby having a means for transmitting the facsimile information from the station A to the station B through the general public network without performing communication by the Internet communication execution means when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value. Mordowitz's system would become more efficient if adapted to incorporate Wegner's teachings, as the most cost effective transmission would be selected to route the facsimile message.

### *Conclusion*

20. Applicant's amendment, regarding **claims 12, 18 through 20, and 22**, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

jrj  
July 19, 2001

Joseph R. Pokrzywa  
Examiner  
Art Unit 2622

  
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